

REMARKS

INTRODUCTION:

In accordance with the foregoing, the claims 8, 13, and 17 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-18 are pending and under consideration. Claims 1-7 have been allowed. Reconsideration is respectfully requested of claims 8-18.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

- (a) it is believed that the amendments of claims 8, 13, and 17 put this application into condition for allowance;
- (b) the amendments were not earlier presented because the Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed; and/or
- (c) the amendments place the application at least into a better form for appeal.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §251:

In the Office Action at pages 2-3, the Examiner rejects claims 8-18 under U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. This rejection is traversed and reconsideration is requested.

The Examiner submits: "A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the

claims in the patent was not an error within the meaning of 35 U.S.C. 252, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application."

However, *C.R. Bard Inc., v. M3 Systems, Inc.*, 48 USPQ2d, 1234 (CAFC, September 30, 1998) recites:

...a primary purpose of the reissue statute is to enable the addition of claims to subject matter not claimed in the original patent. (emphasis added) See *Scripps Clinic & Res. Found'n v. Genentech, Inc.*, 927 F.2d 1565, 1575, 18 USPQ2d 1001, 1009 (Fed. Cir. 1991) (purpose of reissue statute is to avoid forfeiture of substantive rights due to erroneously claiming less than entitled, through error without intent to deceive); *In re Wilder*, 736 F.2d 1516, 1518-19, 222 USPQ 369, 371-72 (Fed. Cir. 1984) (purpose of reissue is to correct errors such as misunderstanding scope of the invention and **claiming less than that to which the inventor was entitled**). (emphasis added)

An inventor's failure to appreciate the scope of an invention at the time of the original patent grant, and thus an initial intent not to claim the omitted subject matter, is a remediable error. (emphasis added) See *In re Amos*, 953 F.2d 613, 619, 21 USPQ2d 1271, 1276 (Fed. Cir. 1991) (**reissue application not subject to rejection for failure to demonstrate initial intent to claim, when subject matter of reissue claims satisfies 112 requirements**) (emphasis added); *In re Weiler*, 790 F.2d 1576, 1581, 229 USPQ 673, 676-77 (Fed. Cir. 1986) ("intent to claim" is shorthand for a means of measuring whether required error is present); *In re Hounsfield*, 699 F.2d 1320, 1322, 216 USPQ 1045, 1048 (Fed. Cir. 1983) (lack of "intent to claim" is only one factor to be considered).

Hence, a newly presented claim in a reissue may be narrower in some aspects, but broader in others, to correct an error in not claiming that to which the inventor was entitled.

It should be noted that MPEP 1412.02.I.B.2.(C) recites:

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc., supra*. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds.

Independent claims 8, 13, and 17 have been amended to show that said claims are not as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art, and recite a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation). Claim 15 already has the limitations of original claims 5 and 8 ("that is iron based and further comprises metallic elements including nickel and cobalt, glass forming elements including boron and carbon, and semi-metallic elements, including silicon, said core being fabricated by heat treating an amorphous magnetic alloy and") that were added to claim 1 of the original application when allowance was obtained and has a further limitation that the core is non-gapped. Hence, claim 15 has not been amended.

Hence, the amended independent claims 8, 13, and 17 and unamended claim 15 in the Reissue Application do not represent improper recapture and are submitted to be allowable under, and compliant with, 35 U.S.C. § 251.

Since claims 9-12 depend from independent claim 8, claim 14 depends from independent claim 13, claim 16 depends from independent claim 15, and claim 18 depends from independent claim 17, respectively, claims 9-12, 14, 16, and 18 in the Reissue Application are submitted to be allowable under, and compliant with, 35 U.S.C. § 251, for at least the reasons that claims 8, 13, 15, and 17 in the Reissue Application are allowable under, and compliant with, 35 U.S.C. § 251.

ALLOWABLE SUBJECT MATTER:

Claims 1-7 are allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

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If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date:

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